



JPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
IN RE THE APPLICATION OF:

Short et al.

Grp. Art. Unit: 3626

Application No: 10/652,849

Examiner: Rangrej, Sheetal

Filing Date: 08/29/03

Date: March 6, 2007

METHOD OF PROMOTING
EMPLOYEE WELLNESS AND
HEALTH INSURANCE STRATEGY
FOR SAME

Atty. Dkt. No: S. WELL

RESPONSE TO OFFICE ACTION

In response to the office action dated December 6, 2006, please consider the following remarks. Reconsideration of the present application is respectfully requested.

Claims 1-20 stand provisionally rejected under 35 USC §101 as supposedly claiming the same invention as that of claims 1-4, 6-15, 17-19 and 21-23 of co-pending and co-owned application number 11/326,763. Applicant respectfully disagrees since the claims are not directed to identical subject matter. MPEP §804 lays out a test for determining the proper application of the double patenting standard of 35 USC §101. In particular, MPEP §804 explicitly lays out a test that states: "Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist." In this case, for instance, claim 1 of the cited application does not require that the group of employees be covered under a State-governed fully insured health insurance policy, whereas claim 1 of the presently pending application does. Thus, if an employer provides a health benefit plan to a group of employees that is federally governed, rather than State governed, but provides a conditional benefit under the plan for employees voluntary participation in a wellness category, such a plan would be covered under claim 1 of the cited application, but not under claim 1 of the present application. Applicant's specification makes it clear that health insurance benefits are either federally governed or State governed. The claims of the presently pending application require the wellness aspect of the health insurance plan to be State governed and fully-insured,

I certify that this paper or fee was mailed with sufficient postage via first class mail on the 6th day of March, 2007 to the Commissioner for Patents,
P.O. Box 1450, Alexandria, VA 22313-1450; Name Printed : Carrie Strenning; Signature *Carrie Strenning*